CERTIFICATE.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1906.

No. 253.

HANKS DENTAL ASSOCIATION

vs.

INTERNATIONAL TOOTH CROWN COMPANY.

A CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

FILED APRIL 7, 1906.

(18,885.)

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JUDD & DETWEILER, PRINTERS, WASHINGTON, D. C., OCTOBER 13, 1903.

1 United States Circuit Court of Appeals, Second Circuit.

HANKS DENTAL ASSOCIATION, Plaintiff in Error, *vs.* INTERNATIONAL TOOTH CROWN COMPANY, Defendant in Error.	Action at Law. Before Wallace and Coxe, Circuit Judges.

This cause comes here upon a writ of error for the review of the judgment of the circuit court for the southern district of New York, entered upon the verdict of a jury in favor of the defendant in error, The International Tooth Crown Company sustaining the validity of a patent and awarding damages for infringement. Upon examination of the record it appears that the sole evidence of infringement was found in the deposition of the president of The Hanks Dental Association, the plaintiff in error, taken pursuant to an order of the circuit court under section 870 *et seq.* of the Code of Civil Procedure of the State of New York, the defendant in error contending the examination of a party before trial, if permitted by the law of the State, is authorized by act of Congress of March 9, 1892. (27 Stat. L., page 7.)

The taking of the deposition was objected to at every stage and when offered in evidence at the trial it was again duly ob-
2 jected to and to its reception the plaintiff in error duly excepted.

Whether this practice is warranted or not is the question upon which we desire the instructions of the Supreme Court.

Question Certified.

Upon the facts above set out the question of law concerning which the court desires the instruction of the Supreme Court is:

Was the order of the circuit court directing the president of The Hanks Dental Association, the defendant in that court, to appear before a master or commissioner appointed pursuant to the provisions of section 870 *et seq.* of the Code of Civil Procedure of the State of New York valid and authorized under the act of March 9, 1892?

In accordance with the provisions of section 6 of the act of March 3, 1891, establishing courts of appeal etc., the foregoing question of law is by the circuit court of appeals for the second circuit hereby certified to the Supreme Court.

March 12th, 1903.

WM. J. WALLACE,
Circuit Judge.
ALFRED C. COXE,
Circuit Judge.

3 [Endorsed:] United States circuit court of appeals, second circuit. Hanks Dental Association, plaintiff in error, vs. International Tooth Crown Company, defendant in error. Certificate for instructions. United States circuit court of appeals, second circuit. Filed Mar. 12 1903 William Parkin, clerk.

4 UNITED STATES OF AMERICA, }
Southern District of New York. }

I, William Parkin, clerk of the United States circuit court of appeals for the second circuit do hereby certify that the foregoing certificate was filed and entered of record in my office on the 12th day of March, 1903, and as directed by the judges of said court, the said certificate is by me forwarded to the Supreme Court of the United States for its action thereon.

New York, March 13, 1903.

[Seal United States Circuit Court of Appeals, Second Circuit.]

WM. PARKIN,
Clerk of the United States Circuit Court of Appeals for the Second Circuit.

5 [Endorsed:] United States circuit court of appeals, second circuit. Hanks Dental Ass'n *v.* International Tooth Crown Co. Certificate.

Endorsed on cover: (Certificate.) File No. 18,885. U. S. C. C. of appeals, 2nd circuit. Term No. 253 Hanks Dental Association vs. International Tooth Crown Company. Filed April 7th, 1903.

23058

Supreme Court of the United States.

OCTOBER TERM, A. D. 1903.

No. 253.

HANKS DENTAL ASSOCIATION

vs.

INTERNATIONAL TOOTH CROWN COMPANY.

On Certificate from the U. S. Circuit Court of Appeals for the Second Circuit.

BRIEF AND ARGUMENT FOR HANKS DENTAL ASSOCIATION.

There is but a single question involved and present for consideration under the certificate of the two judges constituing the Court of Appeals, and such question certified, and the facts antecedent to the condition upon which the question certified is founded, are so well and concisely stated in the certificate, that we herewith quote the same in full.

"UNITED STATES CIRCUIT COURT OF APPEALS,
SECOND CIRCUIT.

Hanks Dental Association, *Plaintiff in Error,* vs. International Tooth Crown Company, *Defendant in Error.*	Action at law. Before Wallace and Coxe, Circuit Judges.

"This cause comes here upon a writ of error for the review of the judgment of the Circuit Court for the Southern District of New York, entered upon

the verdict of a jury in favor of the defendant in error, The International Tooth Crown Company sustaining the validity of a patent and awarding damages for infringement. Upon examination of the record it appears that the sole evidence of infringement was found in the deposition of the President of The Hanks Dental Association, the plaintiff in error, taken pursuant to an order of the Circuit Court under Section 870 *et seq.* of the Code of Civil Procedure of the State of New York, the defendant in error contending the examination of a party before trial, if permitted by the law of the State, is authorized by Act of Congress of March 9, 1892. (27 Stat. L., page 7.)

" The taking of the deposition was objected to at every stage and when offered in evidence at the trial it was again duly objected to and to its reception the plaintiff in error duly excepted.

" Whether this practice is warranted or not is the question upon which we desire the instructions of the Supreme Court.

" QUESTION CERTIFIED.

" Upon the facts above set out the question of law concerning which the court desires the instruction of the Supreme Court is:

" Was the order of the Circuit Court directing the President of The Hanks Dental Association, the defendant in that Court, to appear before a master or commissioner appointed pursuant to the provisions of section 870 *et seq.* of the Code of Civil Procedure of the State of New York valid and authorized under the act of March 9, 1892?

" In accordance with the provisions of section 6 of the act of March 3, 1891, establishing courts of appeal, etc., the foregoing question of law is by the Circuit Court of Appeals for the second circuit hereby certified to the Supreme Court.

" March 12th, 1903.

" WM. J. WALLACE,
" Circuit Judge.
" ALFRED C. COXE,
" Circuit Judge."

Argument and authorities presented in detail as to the above question certified.

An examination of all the authorities show that ever since the decision in *Fogg* v. *Fiske*, 19 Fed., 235, it has been the settled practice in the federal courts (with the possible exceptions hereafter noted) that in an action brought in that court, an examination of an adverse party in advance of the trial cannot be had, because such an examination conflicts with Section 861 of the Revised Statutes. Judge Wallace, in writing the opinion in *Fogg* v. *Fiske, supra*, said:

> "It is well settled in this circuit that Section 914, Rev. St. for conforming the practice in the federal courts in suits at common law as near as may be to that of the state courts, does not apply to the taking of testimony because the Statutes of Congress cover the whole subject; and these statutes not only do not provide for the examination of a party as a witness for the adverse party before the trial in actions at law, but do not permit evidence thus obtained to be used upon the trial as a substitute for the oral examination of the witness. Rev. St., 861. *Beardsley* v. *Littell*, 14 Blatchford, 102. *U. S.* v. *Ping*, 4 Fed. Rep., 714. If, therefore, this was an action originally brought in this court, the plaintiff should not be permitted to proceed with the examination of the defendant.

This decision was shortly thereafter followed by Judge Dyer in the United States Circuit Court, Eastern District of Wisconsin, *Easton* v. *Hodges*, 7 Biss., 326, the court saying:

> "Since Congress has thus legislated so generally and fully upon the subject of evidence and modes of proof and examination, it must be held to govern in the Federal Courts, and to exclude the application in

those courts, of the practice in the State Courts upon that subject."

The rule laid down in *Fogg* v. *Fisk, supra,* was finally and conclusively settled by the decision of this court in *Ex parte Fisk,* 113 U. S., 713, that:

> " The statute of New York, which permits a party to a suit to be examined by his adversary as a witness at any time previous to the trial in an action at law, is in conflict with the provision of the Revised Statutes of the United States, which provides that 'the mode of proof in the trial of actions at common law shall be by oral testimony and examination of witnesses in open court, except as hereinafter provided' (Sec. 861). None of the exceptions afterwards found in Sections 863, 866 and 867 provide for such examination of a party to the suit in advance of the trial as the statute of New York permits. 'The courts of the United States, sitting in New York, have no power therefore to compel a party to submit to such an examination and no power to punish him for refusal to do so.' "

Since the decision in the case of *Ex parte Fisk, supra,* Congress enacted a law to "Provide an additional mode of taking depositions of witnesses in causes pending in the courts of the United States," which is as follows:

> " In addition to the mode of taking depositions of witnesses in cases pending at law or in equity in the district and circuit courts of the United States, it shall be lawful to take the depositions or testimony of witnesses in the mode prescribed by the laws of the state in which the courts are held." Act of March 9th, 1892, 27 Stat., 7.

The decisions upon this question since the passage of this law are as follows:

Tabor v. *Indianapolis Journal,* 66 Fed. Rep., 423 (p. 424):

> " Although no motion has been made by the de-

fendant to strike out the interrogatories filed with the complaint, the court feels constrained *sua sponte* to strike them out. It is settled by the rule of practice in this court that the plaintiff will not be permitted to file interrogatories to be answered by the defendant, with his complaint, in a common law action. This principle is established by the decision of the Supreme Court of the United States in *Ex parte Fisk*, 113 U. S., 713, and later cases in the Federal Courts follows the doctrine of this case."

Shellabarger v. *Oliver*, 64 Fed. Rep., 306 (p. 308):

"It will be observed that the Act of 1892, in addition to the then existing modes of taking depositions specifically adopts the mode prescribed by the laws of the state in all cases pending, both at law and in equity in the United States Courts; but it would be going too far to assume that Congress, in adopting the mode of taking such depositions and testimony intended to add new cases for taking and reading such testimony to those already set forth in Sections 863-866. It adopts the mode or manner of taking the deposition practiced in the State Courts, but not the causes or grounds for taking such depositions. Those remain as heretofore prescribed, and it is perhaps reasonable to assume that, with this exception, we may safely take the laws of the states as our guide in all matters pertaining to the taking of depositions in law and equity cases pending in the Federal Courts."

Seeley v. *Kansas City Star*, 71 Fed. Rep., 554 (p. 556):

"While the manner of taking depositions in actions pending in the United States Courts, both at law and in equity, in addition to the provisions and methods theretofore existing, has been extended by Act of Congress (27 Stat., 7) so as to permit a party to take them 'in the mode prescribed by the law of the state in which the courts are held' it goes only to the mode of taking without in any degree touching or enlarging the limitations under which a deposition may be taken and used in the Federal Courts."

National Cash Register v. *Leland*, 77 Fed. Rep., 242 (p. 243):

> "The plaintiff, however, claims that the mode of proof in trials at law in the Federal Courts was enlarged by the Act of Congress of March 9th, 1892 (2 Sup. Revised St., p. 4), and that depositions may now be taken and become proofs in the Federal Courts and that interrogatories may be filed, to be answered on oath by the adverse party and become proofs in accordance with the provisions of the practice act governing the practice in the State Courts of Massachusetts. In our view, the Statute of 1892 does not enlarge the instances in which depositions may be taken, or in which answers may be obtained upon interrogatories for use as proofs in the Federal Courts. It was only intended to simplify the practice of taking depositions by providing that the mode of taking, in instances authorized by the Federal Courts might conform to the mode prescribed by the laws of the state in which Federal Courts were held. The title of the act, and the language employed in the act itself as well, clearly indicate that nothing further was intended. It is to be presumed that if Congress had intended to radically change the mode of proof and authorize the taking of depositions in instances not theretofore authorized by the federal statutes and to confer additional rights to obtain proofs by interrogatories addressed to the adverse party in actions at law, including discovery of facts and documents material to the defense in support of the suit in advance of the trial, as is provided by the Massachusetts practice act in question, it would have done so in apt and unmistakable language."

Despeaux v. *Pennsylvania R. R.*, 81 Fed. Rep., 897:

> DALLAS, Circuit Judge. "The plaintiffs have moved for an order on A. J. Cassatt, requiring him to testify under the eight-day rule pending herein, touching a certain agreement. The eight-day rule referred to was entered under Clause 3 of Rule 10 of

the rules at law of this court, which were adopted in or about the year 1882. That clause is as follows:

"'A rule may be entered by either party to take the depositions of witnesses without regard to the circumstance of their being ancient, infirm, or going witnesses, stipulating, however, eight days notice to the adverse party subject nevertheless in all other respects to existing rules and regulations.'

"This provision was included, as I am informed, in a body of rules which the bar, or a committee thereof, submitted to the court, and which was therefore promulgated about eighteen years ago. This clause seems to have been derived from a rule of the courts of the State of Pennsylvania in which no doubt it may be properly enforced, but its validity as prescribing a mode of procedure for this tribunal is attacked both on behalf of the witness, and of the defendant, upon the ground that it is in conflict with Section 861 of the Revised Statutes. It is not desirable that I should pass upon this broad question on this application. It is enough for the present purpose that I should say that it is not pretended, in this instance, that any fact exists to bring the proposed examination within any of the specified exceptions to the section which has been referred to and which is in these words, 'The mode of proof in the trial of actions at common law shall be by oral testimony in open court except as hereinafter provided.' In my opinion, the very question now presented was decided in *Ex parte Fisk*, 113 U. S., 713, and in such manner as to preclude the granting of the order now asked for. I cannot agree that 'the question is one of personal privilege of A. J. Cassatt.' It is a question of the court's authority. The statute having prescribed the 'mode of proof' neither as respects the witness nor a party can a different mode be substituted. Nor can I sustain the plaintiff's contention that 'the defendant is estopped.' It is not necesary to determine the dispute as to which side introduced the agreement about which it is proposed to examine the witness. The plaintiff's right to examine him at

the proper time and place upon that or any other subject is not now for decision; but that the court has no power to subject him to the particular examination proposed or to any other, by the method now insisted upon, I have no doubt."

Motion for rehearing. DALLAS, Circuit Judge:

"The two cases referred to in the properly candid brief submitted by plaintiff's counsel upon this motion for re-argument of his motion for an order requiring Mr. Cassatt to testify are both squarely against the granting of the original motion. I follow the decisions in those cases with entire satisfaction. I think it would be unfortunate if the Act of March 9th, 1892, had been differently construed. Where, as in this instance, no good reason appears for taking the testimony of a witness by deposition and in advance of the trial instead of in open court, the latter which is the usual and regular course is much to be preferred."

REPORTER'S NOTE:

"The cases cited upon plaintiff's brief on motion for re-argument, which are referred to in the opinion are *Shellabarger* v. *Oliver*, 64 Fed. Rep., 306, and *Register Co.* v. *Leland*, 77 Fed. Rep., 242."

United States v. *50 Boxes, etc.*, 92 Fed. Rep., 601:

BROWN, J.: "Speaking of the Act of 1892, 'this apparently applies to all depositions authorized to be taken under federal law (*Cash Register Co.* v. *Leland*, 77 Fed. Rep., 242), and it is a clear recognition of the existing mode' (*i. e.*, a lawful mode) of taking depositions from the state practice and at the same time, it *authorized* the latter method, thus giving a legislative sanction to the following of the rule of the state practice in that regard, if desired 'in addition' to the former method. Several decisions had previously declared the same option to exist. 5 Dill., 481; Fed. Cas. No. 4,871; 22 Fed., 198."

Texas & Pacific Ry. v. *Wilder*, 92 Fed. Rep., 953:

> "It is not to be presumed that Congress intended that depositions taken in the mode prescribed by the State law should be read in evidence, even though at the trial the witnesses could be had, and yet that testimony taken under the Revised Statutes of the United States, Sec. 863, could not be read under the same circumstances.
>
> "It is plain to us that no such discrimination against the Federal Statute was intended by Congress and that the Act of March 9th, 1892, refers only as appears from its plain reading to the mode and manner of taking testimony and not to its effect after it is taken, nor to the conditions under which it may be read."

National Cash Register Co. v. *Leland*, 94 Fed. Rep., 502, page 505:

> "The plaintiff further contends that, even if the statutory interrogatories be treated as the taking of an oridnary deposition, and hence forbidden by Section 861, yet they are permitted by chapter 14 of the Acts of 1892 (27 Stat., 7), which permits the taking of depositions in the mode prescribed by the laws of the state in which the courts are held. This position seems to us plainly tenable. The Act of 1892, as stated by the learned judge in the Circuit Court, was intended only 'to simplify the practice of taking depositions by providing that the mode of taking in instances authorized by the federal laws might conform to the mode prescribed by the laws of the state in which federal courts were held,' and not 'to authorize the taking of depositions in instances not heretofore authorized by the federal statutes, and to confer additional rights to obtain proofs by interrogatories addressed to the adverse party in actions at law.' For these reasons, the exception to the refusal of the judge of the Circuit Court to default the defendants must be overruled."

In the case of *International Tooth Crown Company* v.

Hanks Dental Association, Judge Kirkpatrick, in vacating order made *ex parte* for the examination of this same witness, Hanks, said:

> "The order heretofore made in this cause for the examination before trial of the defendant therein must be vacated. The procedure prescribed by Section 861, Rev. Stat., which provides that 'the mode of proof in the trial of actions at common law shall be by oral testimony and examination of witnesses in open court' as interpreted by the Supreme Court in *Ex parte Fisk,* 113 U. S., 721, has not been altered by the Statute of 1892 (29 St., 7).
>
> "The latter relates only to the 'Mode of taking the depositions of testimony of witnesses' in such cases as depositions or testimony were then authorized to be taken and was not intended to provide for an additional mode of proof in the trial of actions at common law. This is the view taken by the learned Court of Appeals of the First Circuit in the case of *The National Cash Register Co.* v. *Leland,* 94 Fed. Rep., 502.
>
> "I concur in the opinion filed therein."
>
> *Zych* v. *American Car & Foundry Company,* 127 Fed. Rep., 728.

This is the last case in the reports upon this subject, and seems to assert that the question certified has been clearly answered and recognized as here contended by "a general concensus of judicial opinion." The court, Judge Thayer, thus stating this fact:

> "In conclusion, it will not be out of place to observe, because the question has been to some extent discussed, that the law as declared in *ex parte* Fisk has not been altered by the Act of Congress of March 9, 1892, *supra,* which was approved subsequent to that decision. This latter question has been considered since the passage of the Act of March 9, 1892, and there seems to be a general concensus of judicial opinion that the act relates merely to the mode of taking testimony, adopting, in that respect, the provisions

of the laws of the various states relative to the method of taking depositions, without altering the conditions prescribed by sections 863 and 866 of the Revised Statutes of the United States, under which depositions for use in the federal courts may be taken. *National Cash Register Co.* v. *Leland*, 37 C. C. A., 372, 94 Fed., 502; *Texas & Pacific Ry. Co.* v. *Wilder*, 35 C. C. A., 105, 92 Fed., 953; *Shellabarger* v. *Oliver* (C. C.), 64 Fed., 306; *National Cash Register Co.* v. *Leland* (C. C.), 77 Fed., 242; *Despeaux* v. *Pennsylvania R. Co.* (C. C.), 81 Fed., 897."

The reported decisions (two only in number) opposed to this construction of the statute are found, first, in this case of the *International Tooth Crown Co.* v. *Hanks Dental Association*, reported in 101 Fed. Rep., at page 306, as follows:

LACOMBE, Circuit Judge. "Ever since the passage of the act of March 9, 1892, it has been uniformly construed in this court as providing additional modes for taking testimony, so as to enable the federal courts to avail of all modes prescribed by the laws of the different states and adapted to the several communities where the courts sit. It is supplementary to section 914, Rev. St. U. S., securing a uniformity in the mode of taking proof, which that section was no doubt intended to secure but which it failed to secure under the interpretation of the Supreme Court in *Ex parte Fisk*, 113 U. S., 724, 5 Sup. Ct. 724, 28 L. Ed. 117. I do not find in *Register Co.* v. *Leland*, 37 C. C. A., 372, 94 Fed., 505, sufficient reason reversing former decisions of this court, nor for declining to avail of any mode of taking proof which the state laws provide. The practice of examination before trial under the New York practice is a most wholesome one. It tends to simplification of the trial, and frequently leads to settlement out of court. The examination should proceed."

Second, this decision of Judge Lacombe is followed later in the case of *Smith* v. *Northern Pac. Ry. Co.*, 110

Fed. Rep., 341, wherein Judge Hanford said, at page 342:

> "The circuit court of appeals for the First Circuit has held that this statute was intended to simplify the practice of taking depositions in the instances authorized by the federal laws, and that it does not authorize the taking of depositions in instances not previously authorized by the federal statutes, and that it does not confer additional rights to obtain proof by interrogatories to be answered by the adverse party in actions at law. *Register Co.* v. *Leland*, 37 C. C. A., 372, 94 Fed., 502. With all due deference to that learned court, the construction thus given to the statute is in my opinion unwarranted, for two reasons, viz.: First, it interpolates and reads into the statute words of limitation which congress did not see fit to put into it; and, second, it fails to give effect to all the words which the act contains, because, if only depositions may be taken in the mode prescribed by the laws of the state, then the words 'or testimony' are meaningless and superfluous, whereas the rules for the interpretation of statutes require the court to give effect to every word of a statute, if it is possible to do so consistently with the manifest intent of the legislature."

The fallacy of the reasoning of this last decision seems to be so obvious that it can be dismissed without discussion; so that so far as the reported cases since the Act of March 9th, 1892, are concerned, it leaves the decision of Judge Lacombe in this case opposed to all of the foregoing cases, and it seems that an analysis of his decision, with the other decisions above mentioned, would settle the law, so far as the reported cases are concerned, up to this date. Judge Lacombe said:

> "Ever since the passage of the act of March 9, 1892, it has been uniformly construed in this court as providing additional modes for taking testimony, so as to enable the federal courts to avail of all modes prescribed by the laws of the different states and

adapted to the severeal communities where the courts sit."

We presume the words "in this court" in the opinion of Judge Lacombe refers to the judges of the Second Circuit; but a very careful search of all the digests and reported cases fails to disclose any reported case on this subject by any of the judges in Second Circuit, since the decision in *Ex parte Fisk,* excepting the decision of Judge Brown in the case of *Fifty Boxes, supra,* which follows, with approval, the decision of the Circuit Court in *Cash Register Co.* v. *Leland, supra,* and is directly opposed to the views of Judge Lacombe. With this exception, this part of the opinion must refer to unreported cases, and we assume that this has been the construction placed on this statute by his Honor, Judge Lacombe, alone.

The opinion further states:

> "It is supplementary to Section 914, Rev. St. U. S., securing a uniformity in the mode of taking proof, which that section was no doubt intended to secure, but which it failed to secure under the interpretation of the Supreme Court in *Ex parte Fisk,* 113 U. S., 724."

Section 914 only provided that the "practice, pleadings and form and modes of proceedings in civil cases" shall conform as near as may be to the practice of the state court.

The act of March 9, 1892, is applicable alone to the taking of depositions, or the testimony of witnesses, and it does not seem that it could be supplementary to this statute when the former statute, under the construction of the court in *Fogg* v. *Fisk, Ex parte, Fisk and Beardsley* v. *Littell,* did not include the subject of the evidence at all.

In the Beardsley case, Judge Blatchford said:

> "The expression 'practice, pleadings and forms and modes of proceedings' is well satisfied, without including it in the subject of evidence."

Judge Wallace said, in *Fogg* v. *Fiske,* in speaking of Section 914, that it

> "Does not apply to the taking of testimony because the Statutes of Congress cover the whole subject."

Judge Lacombe's opinion further states:

> "I do not find in *Register Co.* v. *Leland,* 37 C. C. A., 372, 94 Fed., 505, sufficient reason for reversing former decisions of this court, nor for declining to avail of any mode of taking proof which the state laws provide."

This seems to be the only paragraph in the opinion that attempts to express that learned judge's reason for his opinion, and we most respectfully submit that it does not state a reason for the decision, but simply that the *Register Co.* v. *Leland, supra,* does not show sufficient reason for overruling his uniform construction of the act of March 9, 1892, and therefore, the court will avail of every mode of taking proof which the state law provides.

The court seems to construe the word "mode" in an unnatural sense. To give the plain meaning to this last sentence it would express the court's opinion if it read, "nor for declining to avail of any instance, or any ground, or any cause for taking depositions which the state law provides." The court, in this instance, puts its finger right on the very ground of objection to its decision in constructing the word "mode," which, in its natural sense, means the manner or form instead of the instance, ground or cause for taking the deposition.

The decision of Judge Lacombe in the case of the parties litigant here present, 101 Fed. Rep., 306, and the sole supporting decision of Judge Hanford, Smith v. Railway Co., 110 Fed. Rep., 341, briefly compared with the body of the law as shown by the above decision.

In *Shellabarger* v. *Oliver, supra,* the court said:

> "It adopts the mode or manner of taking depositions in the state courts, but not the causes or ground for taking such depositions."

In *Tabor* v. *Indianapolis*:

> "This principle is established by the Supreme Court in *Ex parte Fisk,* 113 U. S. 713."

In *Seeley* v. *Kansas City Star,* the court said:

> "It goes only to the mode of taking without in any degree touching or enlarging the limitations under which the deposition may be taken."

In the *National Cash Register Co.* v. *Leland, supra,* the Circuit Court said:

> "It was only intended to simplify the practice of taking depositions by providing that the mode of taking in instances authorized by the Federal courts might conform to the laws of the state in which federal courts were held."

And:

> "The title of the act and the language employed in the act itself as well, clearly indicate that nothing further was intended."

And further:

> "It is to be presumed that if Congress had intended to radically change the mode of proof . . . it would have done so in apt and unmistakable language."

In *Despeaux* v. *Pennsylvania, supra,* Judge Dallas said:

> "I follow the decisions in those cases with entire satisfaction (*Shellabarger* v. *Oliver* and *Register Co.* v. *Leland, supra*). I think it would be unfortunate if the Act of March 9th, 1892, had been differently construed."

In the case of the *United States* v. *50 Boxes,* 92 Fed., 601, Judge Brown said:

> "This apparently applies to all depositions authorized to be taken under federal law. . . . Several decisions had previously declared the same option to exist."

This means the option of following the federal practice as to the mode of taking the depositions in instances authorized by the federal law, or following the mode authorized by the law where the courts sit.

In *Texas and Pacific Ry.* v. *Wilder, supra,* the Circuit Court of Appeals of the Fifth Circuit said:

> "It is plain to us that no such discrimination against the federal statutes was intended by Congress and that the Act of March 9, 1892, refers only as appears from its plain reading, to the mode and manner of taking testimony."

In the *National Cash Register Co.* v. *Leland, supra,* the Circuit Court of Appeals of the First Circuit, said:

> "This position seems to us perfectly untenable. . . . That the act was intended only to simplify the practice of taking depositions and not to authorize the taking of the depositions in instances not heretofore authorized by the federal statutes."

And in the opinion of Judge Kirkpatrick, *supra,* it is said:

> "The latter (statute) relates only to the 'mode of taking the depositions,'" and "Was not intended to

provide for an additional mode of proof in the trial of actions at common law."

In the case of *Zych* v. *American Car & Fdry. Co.*, 127 F. R., 728, the court said:

> "This latter question has been considered since the passage of the Act of March 9, 1892, and there seems to be a general concensus of judicial opinion that the act relates merely to the mode of taking testimony, adopting, in that respect, the provisions of the laws of the various states relating to the method of taking depositions, without altering the conditions prescribed by Sections 863 and 866 of the Revised Statutes of the United States."

The above decision of Judge Lacombe, we submit, appears in strong and unfavorable contrast not only as to the law, but as to the logic, by the above comparison.

A decision of this court believed to be practically controlling and decisive as to the question certified.

Since the passage of the Act of March 9, 1892, and the decision in *Ex parte Fisk*, this court has had practically this same question presented to it in the case of the *Camden and Suburban Railway Co.* v. *Stetson*, 177 U. S., 172. At page 176, the court says:

> "In *Ex parte Fisk*, 113 U. S., 713, the statute of the State of New York, in relation to the examination of parties before trial, was held to be in conflict with the act of Congress providing for the examination of witnesses in courts of the United States, and was, therefore, inapplicable in those courts; but the statute in this case is not in conflict with any statute of the United States. It does not conflict with section 861 of the Revised Statutes, providing for the oral examination of witnesses in open court. On the contrary, whatever information may be obtained

by the surgeon who examines the plaintiff under the statute in question can be availed of only by the defendant's producing the witness and examining him in open court, or by deposition, if he come within the exception mentioned in section 863 and the following sections.

" The validity of this statute has been affirmed by the Supreme Court of New Jersey in *McGovern* v. *Hope,* 42 Atl. Rep., 830; to appear in 63 N. J. Law. The opinion of the court was delivered by Mr. Justice Depue and the court held that the act was within the power of the legislature, and was not an infringement upon the constitutional rights of the party.

" The validity of a statute of this nature has also been upheld in *Lyons* v. *Manhattan Railway Co.,* 142 N. Y., 298, although the particular form of that statute would probably be regarded as conflicting with the law of Congress in relation to the examination of a party as a witness before trial, and hence might not be enforced in courts of the United States sitting within the State of New York, but the validity of a statute providing for the examination of the person of a plaintiff in an action to recover for injuries is upheld and declared not to be in violation of the constitutional rights of the party. . . .

" But by reason of the statute of New Jersey, in which state this action was brought, there being no laws of Congress in conflict therewith, we hold that the courts of the United States therein sitting have the power under the statute and by virtue of section 721 of the Revised Statutes of the United States to order the examination of the person of the plaintiff, and we, therefore, answer the third question of the court below in the affirmative, and it will be so certified."

We contended in the court below that in this case the decision in *Ex parte Fisk* is apparently quoted as still being in full force and effect and not modified or in any way abrogated by the Act of March 9, 1892.

And that it was to be presumed that at the time of the

decision in this case, this Act of March 9, 1892, was before this court, and that it considered it had so little bearing upon the question that it was not even mentioned in the opinion.

The legislature of New Jersey had enacted a law, providing for the physical examination of a plaintiff in a personal injury suit. The Supreme Court of New Jersey had held this law to be constitutional, and if the word "Mode" in the Act of March 9, 1892, meant that the federal courts could avail of every ground or cause for taking a deposition, or for the examination of a witness in advance of a trial, it would seem that this court would have said that this act applied in this case, and would not have gone to the length of distinguishing the question in that case from the question decided in *Ex-parte Fisk* and the *Botsford* case. But quite the contrary. We take it this court was so thoroughly in accord with the decision of the Circuit Court of Appeals of the first circuit when it said "That proposition was so plainly untenable" that it did not even consider it of sufficient importance to mention the Act of 1892 in this opinion.

We contended also in the court below that in this opinion, this court not only says plainly and clearly that there can be no examination of a witness in advance of the trial in an action pending in the federal courts in the state of New York, but even goes further and says that there cannot be a physical examination of a plaintiff in a personal injury suit in advance of the trial, because

> "The particular form of that (N. Y.) statute would probably be regarded as conflicting with the law of Congress in relation to the examination of a party as a witness before trial, and hence might not be enforced in the courts of the United States sitting within the State of New York."

The objection that this court found to the New York statute is pointed out clearly and decisively in *Lyons* v. *Manhattan Railway Co.*, 142 N. Y., 298, which is quoted in the opinion, where the New York Court of Appeals said, at page 305, referring to the New York statute:

> "The statute has in terms provided that the physical examination shall be procured in the same way and as part of an examination of the party before trial, and in that way only and by conforming to the general provisions of law on the subject can the object and purpose of the amendment ever be attained."

And in a very elaborate opinion the court holds that a physical examination of a plaintiff, under the New York statute, can not be had separate and apart from an oral examination at the same time.

Under the opinion in the Camden Railway case, *supra,* we contended in the courts below and here contend that this court has said positively and distinctly that there can be no examination of a party or a witness under the New York statute in advance of the trial, and that even a physical examination might not be compelled in the federal courts sitting within the state of New York.

We take it that the opinion in this case is strongly decisive of the question raised in the present action.

To construe the word "mode" in the Act of March 9th, 1892, as meaning instance, grounds or causes would be giving it an unnatural and strained meaning.

The dictionaries define the word "mode" as follows:

Webster's International Dictionary (1901):

> MODE. *n.* (L, modus—a measure, due or proper measure, bound, manner, form, akin to E. mete.)

> Manner of doing or being; method; form; fashion; custom; way; style; as the mode of speaking; the mode of dressing.

Bouvier's Law Dictionary:

> MODE. The manner in which a thing is done; as the mode of proceeding, the mode of process.

Abbott's Law Dictionary:

> MODE. Manner in which anything is done.

And in the light of these definitions, to contend that the word "mode" means anything other than form, manner, style, fashion or method, would be giving it a meaning absolutely new, and one that has never before, under any circumstances been attributed to it. But the burden of the contention of counsel on the other side, as shown by his brief filed in the court below, seemed to be that Congress did not use the word "mode" in its natural and ordinary sense, but in another that had been established by previous Acts of Congress, and argues that the word as used in Section 861 has a "broader and more general significance than that of relating to mere matters of detail in the taking and preparation of testimony." The whole argument is destroyed by failure to observe the different purposes of the two acts.

Section 861. "The mode of *proof* . . . shall be by oral testimony."

Act of 1892. "In addition to the mode of *taking depositions.*"

The word "proof" in Section 861 means production of evidence. "Taking depositions" means the taking and reducing of testimony of the witness to writing, of course, in the instances authorized by the exceptions. The purpose of both acts is clear; the first, for the manner of producing evidence at the trial; the second, for an

optional method of taking depositions in authorized instances. But it was further contended in that brief, that various debates, reports of the Judiciary Committee, etc., on this act, contained in the Congressional Record, show that the word was used in another than its ordinary sense.

How perfectly ridiculous and absurd to contend that the final law does not express the result of the deliberations of its framers, but if the real meaning is to be ascertained, you must delve into the debates and the actions and reports of the committees of its framers. Would any statute ever be safe under such a ridiculous rule of construction? The whole trouble with this contention is that it attempts to *create ambiguity*. As this question is forever set at rest by this court, it is useless to pursue it further.

This court, adopting the language of Judge Wallace as its own, in the case of *Bate Refrigerating Co.* v. *Sulzberger*, 157 U. S., at page 33, said:

> " If it were proper to treat this question as an original one, it would be necessary first to inquire whether there is any ambiguity in the language of the statute. If there is not, the duty of the court is to give effect to its obvious meaning, notwithstanding it may be thought to make an unreasonable and harsh innovation upon the pre-existing privileges of our own inventors. It is not only the safer course to adhere to the words of a statute, construed in their ordinary import, instead of entering into any inquiry as to the supposed intention of Congress, but it is the imperative duty of the court to do so. Where the meaning of the Revised Statutes is plain the court cannot look to the sources of the revision to ascertain whether errors have or have not been committed by the revisers."

And the court said, at page 36:

> " In our judgment the language used is so plain and

unambiguous that a refusal to recognize its natural, obvious meaning would be justly regarded as indicating a purpose to change the law by judicial action based upon some supposed policy of Congress. But, as declared in *Hadden* v. *Collector*, 5 Wall., 107, 111, 'what is termed the policy of the government with reference to any particular legislation is generally a very uncertain thing, upon which all sorts of opinions, each variant from the other, may be formed by different persons. It is a ground much too unstable upon which to rest the judgment of the court in the interpretation of the statutes.' 'Where the language of the act is explicit,' this court has said, 'there is great danger is departing from the words used, to give an effect to the law which may be supposed to have been designed by the legislature. . . . It is not for the court to say, where the language of the statute is clear, that it shall be so construed as to embrace cases, because no good reason can be assigned why they were excluded from its provisions.' *Scott* v. *Reid*, 10 Pet. 524, 527."

In *Hamilton* v. *Rathbone*, 175 U. S., 414, at page 419, this court said:

"The general rule is perfectly well settled that where a statute is of doubtful meaning and susceptible upon its face of two constructions, the court may look into prior and contemporaneous acts, the reasons which induced the act in question, the mischiefs intended to be remedied, the extraneous circumstances, and the purpose intended to be accomplished by it, to determine its proper construction. But where the act is clear upon its face, and when standing alone, it is fairly susceptible of but one construction, that construction must be given to it. Heydon's case, 3 Fed. Rep., 76; *United States* v. *Freeman*, 3 How., 556; *Smythe* v. *Fiske*, 23 Wall., 374; *Platt* v. *Union Pacific Railroad Co.*, 99 U. S., 48; *Thornley* v. *United States*, 113 U. S., 310; *Viterbo* v. *Friedlander*, 120 U. S., 707, 724; *Lake County* v. *Rollins*, 130 U. S., 662; *United States* v. *Goldenberg*, 168 U. S., 95."

At page 421:

"Indeed, the cases are so numerous in this court to the effect that the province of construction lies wholly within the domain of ambiguity, that an extended review of them is quite unnecessary.

"The whole doctrine applicable to the subject may be summed up in the single observation that prior acts may be resorted to, to *solve,* but not to *create* an ambiguity."

Hardcastle on Statutory Construction, page 75:

"Strictly speaking, there is no place for interpretation or construction except where the words of a statute admit of two meanings. 'Where the language of an act is clear and explicit, we must give effect to it, whatever may be the consequences, for in that case, the words of the Statute speak of the intention of the Legislature.'

"In other words, if the language used by the legislature is precise and unambiguous, a court of law at the present day has only to expound the words in their natural and ordinary sense. *'Verbis plane expressis omnino standum est.'*

"In *McGowan* v. *Bane* (1891), App. Cases 401, at 409, Lord Watson laid down the Canon as follows:

"'It is said for some reason the primary and natural meaning of the words is to be extended—I am at a loss to see why. I think an act of Parliament, an agreement or other authoritative document, ought never to be dealt with in this way unless for a cause amounting to a necessity or approaching it.'

"It will be remembered that the authors of the document could always have put in the necessary words if they had thought fit. If they did not, it was because they thought of the matter and did not, or because they did not think of the matter. In neither case ought the court to do it. In the first case, it would be to make a provision opposed to the intention of the framers of the document; in the other

case, to make a provision not in the contemplation of these framers."

Section 861 of the Revised Statutes, with the exceptions mentioned in the following sections up to 870, is a special statute providing exclusively for the production of testimony at the trials in actions pending in the Federal Court.

The Act of March 9, 1892, is a general statute, providing for the mode of taking testimony according to the state practice in instances authorized by the federal statutes in all the states and territories throughout the Unied States. It adopts the practice of the different states in instances authorized by the federal statutes. There is not even a breath of suspicion of a repealing clause in the Act of 1892, repealing any part or any clause of Section 861, *et seq.* of the Revised Statutes. It does not mention these former statutes; it does not by its title or the wording of the act, attempt to add to or create any additional exceptions, and we submit that even if the court shall consider the word "mode" to mean additional instances, or grounds, or causes, that even then, it could not have the effect of adding to this former special statute, or creating any additional exception, because it is a general statute, and does not attempt in any way to repeal the former special act.

In *Rodgers* v. *United States*, 185 U. S., page 83, this court said, at page 87:

> "It is a canon of statutory construction that a later statute, general in its terms, and not expressly repealing a prior special statute, will ordinarily not effect the special provisions of such earlier statute. In other words, where there are two statutes, the

earlier special and the later general—the terms of the general broad enough to include the matter provided for in the special—the fact that the one is special and the other is general creates a presumption that the special is to be considered as remaining an exception to the general, and the general will not be understood as repealing the special, unless a repeal is expressly named, or unless the provisions of the general are manifestly inconsistent with those of the special."

Congress never intended to adopt all prospective instances or grounds that the State Legislatures might hereafter enact as a valid instance or ground for taking a deposition by the Federal Courts in that State.

If an unnatural construction is to be put upon this Act of Congress, and it is to be held that this act adopts not the mode or method of taking depositions as the natural meaning of that word is understood, but that it adopts all instances or grounds that might be authorized by the state legislature, not only at the time of the passage of the law, but of any instance or ground that the state legislature might authorize in all the time to come, it would be adopting a practice and authorizing the taking of depositions in instances which were not in existence at the time of the passage of the act. It would not only adopt all of the instances of the state legislature at the time of the passage of the act, but it would adopt any that the state legislature might enact in the future, however wild and unreasonable, or against the very intent of the framers of that act, they might be, so that they did not infringe on the constitutional right of the witness or person to be examined.

I think it can be safely said that no legislative body in the world has ever adopted anything more than a prospective practice or mode of proceeding of an inferior legislative body or municipality, and that they have never at any time adopted the prospective enactments of an inferior tribunal further than as to the form of proceedings in instances already authorized by the superior legislative body, and that their prospective adoptments have never been any other than adoptions of form, and never in any case have they adopted prospective matters of substance. To hold any other view would be to say that Congress had released and renounced all of its right to legislate on the question of taking depositions and producing evidence in trials in the federal courts and conferred all of this right on the legislatures of the different states by adopting their present laws and all their future enactments in this respect. To follow out the contention of the opposition to its logical conclusion, the instances in which depositions may be taken by the state law in a state less conservative than New York should be taken for illustration.

In Ohio, the statutes provide:

Section 5273:

> " Written notice of intention to take a deposition shall be given to the adverse party, except in case in which it is to be taken under a special commission. and shall specify the action or proceeding, the name of the court or tribunal in which the deposition is to be used, and the time and place where it will be taken, and in case the deposition of a party to the suit be taken, it shall not be used in his own behalf, unless the deposition specified that his deposition would be taken; the notice shall be served upon the adverse party, his agent or attorney of record, or left at the usual place of abode of such party or his agent, and the deposition shall only be used against such parties

as are served with notice in one of the modes prescribed; the notice shall be served so as to allow the adverse party sufficient time, exclusive of Sundays, the day of service and one day for preparation, to travel by the usual routes and modes of conveyance to the place named in the notice and the examination may, if so stated in the notice be adjourned from day to day."

Section 5265:

"The deposition of a witness may be used in the following cases:

"1. When the witness does not reside in or is absent from the country where the action or proceeding is pending, or by change of venue, is sent for trial.

"2. When the witness is dead, or from age, infirmity or imprisonment is unable to attend court.

"3. When the testimony is required upon a motion or when the oral examination of the witness is not required."

Section 5243:

"A party may be examined as if under cross-examination, at the instance of the adverse party either orally or by deposition, as any other witness, but the party calling for such examination, shall not be concluded thereby, but may rebut it by counter-testimony."

Section 5252:

"Disobedience of a subpœna, a refusal to be sworn, except in case of a refusal to pay fees on demand, a refusal to answer as a witness or to subscribe a deposition, when lawfully ordered, may be punished as a contempt of the court or officer by whom the attendance or testimony of the witness is required."

Section 5254 provides that the court or officer may punish the witness for contempt in failing to answer, etc.

In *Decamp* v. *Archibald*, 50 O. S., 618, decided by the

Supreme Court of Ohio, December 5, 1893, the court said that,

> "The object of this proceeding is to reverse an order of the court of Common Pleas of Hamilton County, affirmed by the Circuit Court, remanding the plaintiff in error to the custody of the sheriff of the county in a proceeding in habeas corpus, the return of the sheriff, showing that the party had been committed to the jail of the county by a notary public for refusing to answer certain questions propounded to him, his deposition being taken at the time before the notary, to be used as evidence in an action then pending in the Superior Court of Cincinnati; and held that 'The power conferred by Sections 5252 and 5254, Revised Statutes on a notary or other officer, in taking depositions, to commit a witness to the jail of the county, for refusing to answer a question, is not judicial in the sense of the constitution, conferring all judicial powers upon the courts of the state.'
>
> "When the question propounded involves no question of privilege on the part of the witness, it is his duty to answer if he is ordered by the notary to do so. The question of its competency is a matter for the determination of the court on the trial of the action in which the evidence is taken; and if he refuses to do so when ordered, he may be committed as a contumacious witness."

A party to an action may take depositions of any witness, his adversary, or his own, at any time after reasonable notice, and at any place. He need not even name the witness whom he proposes to examine further than to say in the notice "sundry witnesses." No order of court is required; no affidavit need be made or filed; no notice need be given of the scope or subject of the proposed examination; in fact he may keep his adversary in absolute ignorance whom his witness is, or on what question or subject he is to be examined. His adversary must be prepared to meet any kind of an examination of any witness, at any

time or place. He may cross-examine his adversary and not be concluded by his testimony, and use it or not on the trial as he sees fit. The deposition may be taken before any notary public who has no power to pass on any questions propounded, but may commit the witness for refusing to answer or be sworn, etc.

Can any one seriously contend that Congress, by the Act of March 9th, 1892, adopted the law of taking deposition in that state? If it did, then an action at law could be tried there wholly on depositions of witnesses and parties residing within a radius of less than one hundred miles from the place where the court was held—were not infirm or going away—if they resided outside of the particular *county* where the court was held.

If this be correct, then in that state the Act of March 9th, 1892, repealed or superseded each and every syllable and line of every previous Act of Congress on the whole subject of evidence.

In *Ex parte Fiske*, after setting out the substance of Sections 861 to 870 of the Revised Statutes, this court said, at page 722:

> "No one can examine these provisions for procuring testimony to be used in the courts of the United States and have any reasonable doubt that, so far as they apply, they were intended to provide a system to govern the practice, in that respect, in those courts. They are, in the first place, too complete, too far-reaching, and too minute to admit of any other conclusion. But we have not only this inference from the character of the legislation, but it is enforced by the language of the law in providing a defined mode of proof in those courts, and in specifying the only exceptions to that mode which shall be admitted.
>
> "This mode is 'by oral testimony and examination of witnesses in open court, except as hereinafter provided.'"

If Congress intended to repeal or suspend the operation of this whole chapter on evidence by the act of 1892, it would have said so in apt and unmistakable language.

The entire practice permitted by Section 870, et seq. of the code of civil procedure of the State of New York, harsh, vicious and indefensible.

We take issue, not only with the law as asserted and laid down in Judge Lacombe's opinion, but also as to the statements of that learned judge as to the asserted wholesomeness and beneficial character of the practice The learned judge thus states his views as to this matter:

> "The practice of examination before trial under the New York practice is a most wholesome one. It tends to simplification of the trial and frequently leads to settlement out of court."

The last statement of the learned judge is probably correct, and in the sense that the case is simplified by settlement without trial, probably correct also; but the reasons for these two results under the New York code lie far outside of any element of justice or equity, and the rights of person or property involved in any litigation. The type and character of the litigation represented by the case at bar clearly illustrates the truth of the clause of contention asserted in the above headlines. The parties interested as defendants in this litigation, and in this question, are personally and individually the thirty thousand dentists practicing their profession in every city and village of this country. Admittedly, and by universal knowledge, with but few exceptions, the individual dentists have but scanty property acquirements, and many of them with their families subsist alone upon the income received from their

practice. The dental profession for more than a quarter of a century as to its individual members has been drawn into the Federal Courts by the thousands in patent litigations upon patents taken out by a certain class of their profession, and acquired and litigated in corporate form thereafter by organization of capital for that purpose. This High Court has more than once been called upon in relation to such litigations and patents, as for example the case of *Smith* v. *Dental Vulcanite Co.*, 93 U. S., 496; the plaintiff in this case, the *International Tooth Crown Co.* v. *Gaylord*, 140 U. S. 63; and there is a long and unbroken line of these cases at the circuit, beginning about the middle of the last half of the last century, and following each other in rapid succession from that time until this. A large percentage of the practice of every dentist is represented by the mothers and daughters of the country, sensitive as to the infirmities and defects of their teeth, and secretive as to these matters even among the individual members of the same family. The practice of every dentist is a personal practice. His appointments are made covering periods of assigned time for successive days. Frequently the infirmities of the teeth and mouths of his patients are such that continuous application and treatment is necessary for right work and results. Any neglect or interference with this work not only means pain to the patients, but frequently ruin to the operation. Manifestly it is a great hardship to compel any dentist to appear before a master, or other court officer, and there disclosing to everybody, not only those interested in the litigation, but whomsoever, through curiosity or malice, would examine the records, the infirmities of the mouths and teeth of his patients, disclosing even their names and addresses, and making permanent court exhibits of the

same, with all the attending results that envy or gossip might circulate regarding such a matter. Manifestly and undeniably, a judgment entered in any accounting at law against a dentist for infringement of a patent would be small. Equally manifestly, also, a proceeding before a master to compel the examination of any dentist, even as to matter of costs, would be large, and out of all proportion to the monetary sum at stake. For these reasons, and others of equal force apparent, we respectfully submit that such drastic remedy as contemplated by this New York practice, would be most unwholesome, and would engender a feeling of hostility to the process of the court greater than any other conceivable. Manifestly, also, this practice cannot be justified in a patent case upon the ground that a plaintiff is endeavoring to ascertain whether an act of infringement has been committed. The act of infringement must be first ascertained, as the foundation and basis of the suit, and if such fact is ascertained, an investigation as to the extent of such infringement, should only be made and permitted in the presence of the court upon trial, where the rights of the patients can be safeguarded, as well as the rights of the dentists. This New York State court practice as to result, is clearly stated in one of the above cases, namely, "it subjects the party to all of the skill of opposing counsel to extract something he may then use or not as suits his purpose." This court in the Bostford case, 141 U. S., 250, and in cases with environments similar to those involved in the case at bar, commenting upon the examination of the plaintiff's person in advance of the trial, expressed its views upon such proceeding as follows (p. 252):

> "The inviolability of the person is as much invaded by the compulsory stripping and exposure as

> by a blow. To compel any one, and especially a woman, to lay bare the body, or to submit it to the touch of a stranger, without lawful authority, is an indignity, an assault and a trespass; and no order or process, commanding such an exposure or submission, was ever known to the common law in the administration of justice between individuals, except in a very small number of cases, based upon special reasons, and upon ancient practice, coming down from ruder ages, now mostly obsolete in England, and never, so far as we are aware, introduced into this country."

Any act or thing done which would tend to simplification of trial, or lead to a settlement out of court, must be an act or thing based upon law, justice and equity. It is easy to see from the above facts and conditions that an individual dentist sued for an infringement of a patent and compelled to submit himself to an examination before a referee or master as contemplated by this act, no matter how iniquitous and groundless such suit might be, would simplify the case by paying any sum of money within his ability so to do, and protect himself and his patients from these proceedings, and would certainly make such settlement "out of court," and even out of the knowledge of third parties. So, also if it were a State Statute practice to revert to earlier methods of court procedure, and it were permissible to string a defendant dentist in a patent case up by the thumbs, as practiced by the Spanish inquisition, or to place him in the pillory or docks, under proceedings before a master. This practice, also, would "tend to a simplification of the trial," and we have no doubt would "frequently lead to settlement out of court."

Neither can such practice be justified under the theory or contention that a patentee is entitled to find out whether his patent has been infringed, and whether a cause

of action exists by reason of this fact. Under these conditions, even under practice of the State Code, no such proceeding is permissible under this act, as shown by the following authorities.

The state courts on this question, hold:

Chunchman v. *Merritt*, 51 Hun. 375:

> "It would seem that the plaintiff's real purpose in the examination of the defendant is not to obtain knowledge of facts which will facilitate the statement of a known and ascertained cause of action, but is rather to find out whether any cause of action whatever really exists in her behalf against these defendants or any of them. Under these circumstances, an examination of a defendant before trial is not authorized by the Statute. To sanction it would be to permit investigations of the most harassing character and give rise to a practice liable to grave abuse."

In *Tenoza* v. *Pelham Hod Elevating Co.*, 50 App. Div., 582:

> "Examination before trial—not granted when it is sought merely to ascertain if a cause of action exists. In an action brought against a corporation and others to recover damages resulting from the death of the plaintiff's intestate, the plaintiff's application for the examination of the officers of the corporation before trial will not be granted where the avowed purpose of such examination is to ascertain the relation of the corporation to the building in which the intestate was killed, in order that the plaintiff may either discontinue the action against the corporation, if such investigation should reveal its non-liability, or for the purpose of preparing for trial in order to amend her complaint for the purpose of recovering against the defendant."

In the matter of *White*, 44 App. Div., 119:

> "An application to examine a witness before the commenecement of a contemplated action against a

third person will not be granted to enable the applicant to determine whether he has a cause of action against such person.

"In the affidavit used upon such an application, the proposed defendant must always be definitely and not tentatively named, and it must be made to appear that the applicant has a cause of action against him."

In *Britton* v. *McDonald*, 3 Misc., 514:

"An adverse examination of a defendant before trial is not allowable for the purpose of discovering a cause of action; so as to authorize such an examination, his testimony must appear to be material, necessary and probably unattainable at the trial."

Burritt v. *Koster*, 7 Misc., 75:

"An exmination of a defendant before trial will not be allowed for the purpose of ascertaining whether the plaintiff has a cause of action."

Byrnes v. *Ladew*, 15 Misc., 413:

"An examination of a defendant before trial cannot be permitted for the purpose of ascertaining whether the plaintiff has a cause of action against him."

Green v. *Carey*, 81 Hun., 496:

"An order will not be made for the examination of the defendant for the purpose of enabling the plaintiff to prepare his complaint, where the purpose of the order is to enable him to determine whether he has one or the other of two causes of action."

Conclusion.

Upon the facts as above set forth, and upon the argument and authorities accompanying the same, we respectfully and confidently submit that the order of the Circuit Court, directing the president of the Hanks Dental As-

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sociation, the defendant in that court, to appear before a Master or Commissioner appointed pursuant to the provisions of Section 870 *et seq.* of the Act of Civil Procedure of the State of New York, was neither valid nor authorized under the Act of Congress of March 9, 1892, and the question certified should be so answered.

CHARLES K. OFFIELD,
CHARLES C. LINTHICUM,
PHILIP B. ADAMS,
Solicitors and of Counsel for Hanks Dental Association, Plaintiff in Error.

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Supreme Court U. S.
FILED
APR 5 1904
JAMES H. McKENNEY,
Clerk.

upreme Court of the United States.

OCTOBER TERM, 1903. No. 253.

HANKS DENTAL ASSOCIATION

against

INTERNATIONAL TOOTH CROWN COMPANY.

BRIEF FOR INTERNATIONAL TOOTH CROWN COMPANY.

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23078

Supreme Court of the United States.

HANKS DENTAL ASSOCIATION,
Plaintiff-in-Error

against

INTERNATIONAL TOOTH CROWN COMPANY,
Defendant-in-Error.

October Term
1903
No. 253.

ON A CERTIFICATE FROM THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

Brief for Defendant-in-Error.

The sole question before this Court is expressed in the inquiry certified as follows:

"Was the order of the Circuit Court directing "the President of the Hanks Dental Association, "the defendant in that Court to appear before a "Master or Commissioner appointed pursuant to "the provisions of Section 870, *et seq.*, of the "Code of Civil Procedure of the State of New "York, valid and authorized under the Act of "March 9, 1892?"

In other words has the Circuit Court, since the passage of the Act of March 9, 1892, power, in its

discretion, to employ modes of proof prescribed by the laws of the State in which said Circuit Court is held?

Said Act of 1892 (27 Statutes at large, page 7) reads as follows:

"Chap. 14. An act to provide an additional "mode of taking depositions of witnesses in causes "pending in the Courts of the United States.

"Be it enacted by the Senate and House of "Representatives in Congress assembled, that, in "addition to the mode of taking depositions of "witnesses in causes pending at law or in "equity in the District and Circuit Courts of the "United States, it shall be lawful to take the dep- "positions, or testimony, of witnesses in the mode "prescribed by the laws of the State in which the "Courts are held."

"Approved March 9, 1892."

It is admitted by defendant-in-error that prior to the passage of this act, an examination of a party before trial could not be had under the New York Code in the Circuit Courts within that state, because of the ruling of this court in *ex parte* Fisk (113 U. S., 724).

The question, in its broadest aspect, relates to the production of evidence in the Federal Courts in actions at law.

U. S. Revised Statutes, Section 861, reads:

> "The mode of proof in common law actions "shall be by oral testimony and examination "of witnesses in open court, except as herein- "after provided."

The other modes of proof, as outlined by the Revised Statutes, are

(*a*) Depositions *de bene esse* (Sec. 863), and
(*b*) Depositions *dedimus potestatem* (Sec. 866):

Section 867, provides as follows:

> "Sec. 867. Any court of the United States "may [italics are counsel's] *in its discretion*, "admit in evidence in any cause before it any "deposition taken in *perpetuam rei memo-* "*riam*, which would be so admissible in a "court of the state wherein such case is pend- "ing, according to the laws thereof."

It will be noted that of these modes of proof, Section 863 refers specifically to "the testimony of any witness in any civil cause" taken by deposition *de bene esse*, and that Section 866 refers altogether to "depositions according to common usage."

FIRST.

The Act of 1892 by its very language adds to the modes of proof theretofore available in the District and Circuit Courts.

The New York practice of examination of a party or witness before trial had been long in existence prior to the passage of the Act of 1892.

As was said by the New York Court of Appeals in Glenney v. Stidwell (64 N. Y., 120, 122, decided in 1876.

> "As a general rule, a court of equity has "jurisdiction to entertain a bill, for discovery "of facts which may aid in the prosecution or "defense of an action in another court, and "which may enable the plaintiff to ascertain "who will be proper parties to the action "* * * . This jurisdiction was conferred "upon the Supreme Court by the Constitution "of 1846" (Art. 6, Sec. 3).

See also Lyon v. Manhattan Ry. Co. (142 N. Y., 306).

It was perfectly proper to require the president of the defendant corporation to appear before a master of the Circuit Court (Code of Civil Procedure, Sec. 872, sub-div. 7 and Sec. 873).

The Circuit Court rightly held that the objection that the order described the referee as a special master is trivial and without merit (112, Fed. Rep., 396).

The Circuit Court also held that the deposition was properly taken and was admissible by virtue of said act (101 F. R., 306).

Such holding constituted a proper exercise of the discretionary power vested in the Circuit Court by said Act of 1892.

The most recent and exhaustively considered expression of judicial opinion on this subject is that in the Ninth Circuit, where the court held:

> "The Circuit Court of Appeals for the First "Circuit has held that this statute was intend- "ed to simplify the practice of taking deposi- "tions in the instances authorized by the "federal laws, and that it does not authorize "the taking of depositions in instances not pre- "viously authorized by the Federal Statutes "and that it does not confer additional rights "to obtain proof by interrogatories to be "answered by the adverse party in actions at "law. Register Co. v. Leland, 37 C. C. A., "372, 94 Fed., 502. With all due deference "to that learned court the construction thus "given to the statute is in my opinion unwar- "ranted for two reasons, viz: First, it inter- "polates and reads into the statute words of "limitation which Congress did not see fit to "put into it; and, second, it fails to give "effect to all the words which the act contains, "because, if only depositions may be taken in "the mode prescribed by the laws of the "State, then the words 'or testimony' are "meaningless and superfluous, whereas the "rules for the interpretation of statutes "require the court to give effect to every "word of a statute, if it is possible to do so

"consistently with the manifest intent of the "legislature. I concur with Judge Lacombe "in his opinion in the case of International "Tooth Crown Co. v. Hanks Dental Ass'n (C. "C.) 101 Fed., 306, in which he construed the "Act of March 9, 1892, as providing additional "modes of taking testimony, so as to enable "the Federal Courts to avail of all modes pre- "scribed by the laws of the different statess "and adapted to the several communitier "where the courts sit; and I especially concur "in his statement that 'the practice of exam- "ination before trial * * * is a most "wholesome one; it tends to simplification of "the trial, and frequently leads to settlement "out of court.' "

Smith v. Northern Pacific R. R. Co., 110 F. R., 341, 343.

The opinion of Judge Lacombe, herein above referred to, is as follows:

"Ever since the passage of the Act of March 9, 1892, it has been uniformly construed in this court as providing additional modes for taking testimony, so as to enable the Federal Courts to avail of all modes prescribed by the laws of the different states and adapted to the several communities where the courts sit. It is supplementary to Section 914, Rev. St. U. S., securing a uniformity in the mode of taking proof which that section was no doubt intended to secure, but which it failed to secure under the interpretation of the Supreme Court in *ex parte* Fisk, 113 U. S., 724, 5 Sup. Ct., 724, 28 L. Ed., 1117. I do not find in Register Co. v. Leland, 37 C. C. A., 372, 94 Fed., 505, sufficient reasons for reversing former decisions of this court, nor for declining to avail of any mode of taking proof which the state laws provide. The practice of examination before trial under the New York practice is a most wholesome one. It tends to simplification of the trial, and frequently leads to set-

tlement out of court. The examination should proceed."

International Tooth Crown Co. v. Hanks Dental Ass'n, 101 Fed. R., 306.

A contrary view had been previously entertained in the First Third and Eighth Circuits as appears by the first four decisions hereinafter referred to. Other casesdo not apply as they were either prior to the Act of 1892 or contain mere *obiter dicta* on this subject.

One of the crucial inquiries in this connection is, what meaning is to be attributed to the word "mode" in Act of 1892. Does it refer to mere "*practice*," or "*form* of procedure" solely, or, to an additional "*mode* of proof," whereby depositions may be had upon grounds not previously specified in the Revised Statutes.

The opinions of the learned judges who have held that the Act of 1892, does not provide an additional "*mode* of proof" evince a cursory treatment of this subject and are solely and expressly based upon the consideration that the word "mode" as contained in the Act of 1892, must be taken to refer only to "*practice*" or "*form*."

In National Cash Register Co. v. Leland (77 F. R., 242); Aldrich, D. J., says: "It" (Act of 1892) "was only intended to simplify *the practice* of "taking depositions by providing that the mode "of taking * * * might conform to the mode "prescribed by the laws of the state" (p. 243). This language and reasoning were adopted, *verbatim*, and apparently without further consideration by the Circuit Court of Appeals in the same case (94 F. R , 502, 505).

In Shellabarger v. Oliver (64 F. R., 306), Foster, D. J., says: "It adopts the mode *or manner* of "taking the depositions *practiced* in the State

"Courts, but not the causes or grounds for taking "such depositions" (p. 308).

In Despeaux v. Penn. R. Co. (81 F. R., 897), Dallas, C. J., as appears by the report and the reporter's note, merely followed, without adding to the reasoning as above stated in Shellabarger v. Oliver and National Cash Register Co. v. Leland.

In Int Tooth Crown Co. v. Vinson, *unreported*, Kirkpatrick, D. J., relied upon, without adding to the reasoning in National Cash Register Co. v. Leland (*supra*).

Defendant-in-error contends that the limitation placed upon the meaning of the word "mode" by these earlier decisions is directly at variance with the meaning previously adjudicated for it by this court in *ex parte* Fisk (113 U. S., 713).

In that case, decided in 1884, and passing solely on the power of the Circuit Court to compel a deposition like that at bar, this court exhaustively examined and construed the Act of 1872 (the "Conformity Act") to determine its effect upon previous acts of Congress establishing the "mode of proof" in U. S. courts, and said, first referring to the Act of 1872:

"This enacts that 'the practice, pleadings and "forms and modes of proceedings' * * * in "the Circuit and District Courts shall conform, as "near as may be to the practice, pleadings and "forms and modes of proceedings * * * in "the courts of the state." * * * "But the Act "of 1789, which made the laws of the states rules "of decision, made an exception when it was " 'otherwise provided by the Constitution, treaties "or statutes of the United States.' The case be- "fore us is eminently one of evidence and proced- "ure * * * Coming to consider whether Con- "gress has enacted any laws bearing on the ques- "tion before us we find the following sections of

"the Revised Statutes * * * Sec. 861: '*The* "*mode of proof*, in the trial of actions at Common "Law, shall be by oral testimony and examination "of witnesses in open court, except as hereinafter "provided.' Sec. 863: 'The testimony of any wit- "ness may be * * * taken by deposition *de* "*bene esse* when the witness lives at a greater dis- "tance from the place of trial than 100 miles,' etc. "* * * The remainder of this section and Sec- "tions 864 and 865 are directory as to * * * "*the manner* of taking, testifying and returning "the deposition to the court. Sec. 866 * * * "the courts may grant a *dedimus potes-* "*tatem* to take depositions according to common "usage, etc. * * * Sec. 867 * * * Secs. "868, 869 and 870 prescribe *the manner* of taking "such depositions (p. 722). * * * These pro- "visions * * * were intended to provide a "system to govern the practice in these Courts (U. "S). * * * It is enforced by the express lan- "guage of the law in providing *a defined mode of* "*proof* in those Courts and in specifying the only "exceptions *to that mode* which shall be admitted.

"This *mode* is by oral testimony and examina- "tion of witnesses in open Court except as herein- "after provided.

"Of course the *mode* of producing testimony "under the N. Y. Code, which was applied to "petitioner, is not oral testimony and examina- "tion of a witness in open Court. * * *

"We now come to inquire if the testimony "sought to be obtained from the petitioner *by this* "*mode* comes within the exception referred to in "Sec. 861. These exceptions relate to cases where "it is admissible to take deposition *de bene esse* "under Sec. 863, or *in perpetuam* * * * under a "*dedimus* * * * under Sec. 866 (p. 723) * "* * These are the exceptions which the statute "provides to its positive rule that the *mode* of trial

"* * * shall be by oral testimony, etc. Its "purpose is to provide a *mode of proof* in trials at "law to the exclusion of all other *modes of proof* "and because the rigidity of the rule may in some "cases work a hardship, it makes exceptions of "such cases as it recognizes to be entitled to "another rule, and it provides that rule for those "cases. Under one or the other all cases must "come * * *. There is no place for exceptions "made by State Statutes" p. 724. And this Court therefore held that, under the Act of 1872, examination of a party before trial, pursuant to the N. Y. Code, could not be compelled by the U. S. Circuit Court.

By the foregoing language, it is understood that this Court has expressly indicated that the word "mode" did not mean "manner" applying the latter word to the provisions of the statutes relating to practice and form, and has manifestly imputed to the word "mode," reference to the *kind* of proof distinguished by the *grounds* upon which the taking thereof proceeded.

And this court also held, in effect, as previously expressly held by Judge Blatchford, in Beardsley v. Littell, 14 Blatch., 102, that in the Act of 1872— "The expression * * * forms and modes of "*proceeding*, is well satisfied without including the "subject of evidence" (p. 105).

In other words, it seems to have been finally adjudicated that the word "mode," when employed by Congress in the collocations,—"mode of proof" and "mode of taking depositions and testimony of witness," does *not* refer merely to "manner" of taking proof, nor to "practice" in that regard, nor to "forms and modes of proceeding" being the other subjects expressly and separately specified in the Conformity Act of 1872, R. S., Sec. 914, but to a "defined mode of proof," "a mode of *produc-*

ing testimony" characterized and distinguished therefore, not by mere incidents of "practice" or "manner" of procedure, but broadly by its conformity with, or dissimilarity from, the three "modes" previously provided in the Revised Statutes, viz: oral in open court, *de bene*, and under *dedimus*.

Any other interpretation is manifestly at variance with the established canons controlling construction. All the Acts of Congress referred to "are *pari materia* and are to be looked to as one statute in explaining their meaning and import."

Patterson v. Winn, 11 Wheat, 386.
Reiche v. Smythe, 13 Wall, 162, 165.
Potter, Dwarris on Statutes, 145.

"In the construction of a statute, although the "words of the act are generally to have a control-"ling effect, yet the interpretation of those words "must often be sought from the surrounding cir-"cumstances and previous history."

Siemens' Administrator vs. Sellers, 123 U. S., 276.
See also Smith vs. People, 47 N. Y., 330, 339.

The Act of 1872, Sec. 914 "The Conformity Act," was addressed expressly to four different things, viz: 1, practice; 2, pleadings; 3, forms of proceeding and 4, *modes* of proceeding.

It is elementary that it was the duty of the Court to attribute to each of these subjects a different meaning.

Potters' Dwarris on Statutes, p. 198.
Montclair vs. Ramsdell, 107 U. S., 152.
In re New York & Brooklyn Bridge, 72 N. Y., 527, 530.

Hence "mode could not mean practice, nor form, as erroneously contended in the National Cash Register and Shellabarger cases, *ante*.

Moreover, "modes of proceeding" in the Act of 1872, had been already held, as stated, not to include, "modes of proof or taking depositions."

Congress therefore addressed itself to the enactment of the Statute of 1892 with a previously established and adjudicated vocabulary to choose from. It must be conceded that it was intent upon expanding the scope of the Statute of 1872 (the Act of Conformity). Had it intended to limit that expansion to the subject of "*practice*" or "*forms of proceeding*" (as contended in the National Cash Register or Shellabarger cases, *ante*) those words would have been the appropriate ones to select, in which case it would merely have re-enacted the Act of 1872, but it passed these over and directed the Act of 1892 to the enlargement of that other subject matter expressed in the Act of 1872, viz: "mode of proceeding," so as to add thereto, expressly, an additional mode of taking proof or depositions as required by Beardsley v. Littell and *ex parte* Fisk.

The conclusion is irresistible that Congress intended by the Act of 1892 to expand the *mode* of proof available in U. S. Courts, so as to bestow upon suitors therein the benefits of any "*modes of producing testimony*" (113 U. S., 723) open to suitors in the State Courts.

Bank for Savings vs. Collector, 3 Wall, 495, 513.

Viterbo vs. Friedlander, 120 U. S., 707, 726.

Hamilton vs. Rathbone, 175 U. S., 414, 419 and cases cited.

And it is also manifest that the Act of 1892 was passed by Congress directly in consequence of the

limitation imposed upon the Conformity Act of 1872 by the decision *in re* Fisk, else Congress would not have employed so identically the language contained in that decision nor have expressly provided that "*in addition* to the mode "of taking depositions of witnesses * * * it "shall be lawful to take the depositions *or testi-* "*mony* of witnesses in the mode prescribed by the "laws of the State, etc."

U. S. v. R. R. Co., 91 U. S., 72, 79.

Therefore this court should interpret the Act of 1892 as *adding* to the oral testimony in open court, as provided in common law actions by Sec. 861, exceptions other than, and in addition to, those provided by Secs. 863 and 866 (*de bene esse* and *dedimus*) to which *ex parte* Fisk had limited the operation of the Act of conformity of 1872.

Durousseau v. U. S. (6 Cranch., 314).
Montclair vs. Ramsdell (107 U. S., 152).
The Emily vs. The Caroline (9 Wheat., 381).

Another consideration which should prove controlling to discredit the National Cash Register and Shellabarger cases, *ante*, is that their effect is to wholly nullify the Act of 1892.

Those decisions attribute nothing more to that act than had been fully enacted in the Conformity Act as interpreted by *In re* Fisk, *ante*. Their premises and reasoning concerning the Act of 1892 are identically the same as that of this court concerning the Act of 1872—no more, no less. The Act of 1872 provided that " * * * the modes of "proceeding (in U. S. Courts) * * * shall "conform to the modes of proceeding in the courts "of the State." * * * The Act of 1892, that *in addition* "to the mode of taking depositions

"(in U. S. Courts) * * * it shall be lawful to "take depositions or testimony of witnesses in the "mode prescribed by the laws of the State."

Beardsley vs. Littell and *ex parte* Fisk held that *in the absence of* an enactment by Congress of other modes of proceeding *to take proof*, additional to those already in the U. S. Revised Statutes, the language of the Act of 1872 was insufficient to add to those already provided by including State modes.

The National Cash Register and Shellabarger decisions treat the Act of 1892 as though it merely re-enacted the portion last quoted from the Act of 1872.

This is not only against the plain letter of the Act of 1892, which by its title provides "*an addi-*"*tional* mode of taking depositions," thus affording the additional express enactment deemed essential by this court, but is directly at variance with all established canons controlling the interpretation and construction of statutes.

> Knowlton v. Moore, 178 U. S., 41, 65, and cases cited.
>
> Holy Trinity Church v. United States, 143 U. S., 457, 462.
>
> Mining Co. v. South Carolina, 144 U. S., 550, 563.
>
> Price v. Forrest, 173 U. S., 410.

It is elementary that a law must be construed, if possible, so as to give it force, and not so as to nullify it, and particularly is this the case where the law in question deals with a subject matter previously held by the courts to have been inadequately secured by previous legislation.

> Wilmot v Mudge, 103 U. S., 217, 221.
>
> Lau. Ow. Bew. v. U. S., 144 U. S., 47, 59, and cases cited.

Holmes v. Carley, 31 N. Y., 289, 290.
Donaldson v. Wood, 22 Wendell, 395.
Dibble v. Hathaway, 11 Hun, 574.
Potter's Dwarris on Stat., sec. 194, n. 13.

Finally, the construction of the Act of 1892 contended for by defendant-in-error would prove wholly advantageous to courts, to suitors, and generally to the administration of justice. The opinions rendered in the Second and Ninth Circuits (*ante*) point out some of the grounds for this conclusion. To these may be added the following considerations:

(1.) The enforcement of the modes of taking depositions or testimony provided by State Statutes, would, in the United States Courts, be limited to cases where, *in the discretion of the Court*, the remedy is "necessary to prevent a failure or delay of justice." This principle is established in Railway Co. v. Horst, 93 U. S., 291, 300.

(2.) The effect of the Act of 1892 would be to afford *within 100 miles from place of trial* no more than is now accorded by R. S., Sec. 863, providing for depositions *de bene esse*, that is to say, an opportunity to thrash out exhaustively in advance of the trial, a multitude of essential though incidental proofs depending frequently, as in the case at bar, on examination of books and accounts and which cannot otherwise be accomplished with requisite certainty and exhaustiveness under the inevitable pressure of proceedings before the jury without unduly pre-empting the time of judge and jury and obstructing the business of other suitors.

For it must be admitted by plaintiff-in-error that, in the case at bar, if Edmund F. Hanks lived more than 100 miles from New York City, such examination before trial could have proceeded *de bene esse*.

Lowrey v. Kusworm, 66 Fed. R., 539.

As the New York Court of Appeals has said:

> "It becomes a fair struggle for truth, and "both parties may participate. The record of "the examination is placed on file and both "sides know what must be met if it is intro- "duced in evidence, as it may be. The statute "upon this construction becomes a valuable "accession to the rules for administering jus- "tice, and not an instrument to be used by "one party to surprise his antagonist at "the trial, or, in some cases, possibly him- "self."
>
> Lyons vs. Manhattan Ry. Co., 142 N. Y., 306.

In the case at bar, the deposition of Hanks, requisite to prove multitudinous acts of infringement of a patent, and receipts therefrom, required several days of examination, and also numerous adjournments before the witness could be induced to produce the books which were indispensable. It seems clear that a "failure or delay of justice" was inevitable in this case without this remedy, not so onerous upon witness as would have been compulsory attendance in court before and at the trial. It may be said that such an examination is necessary to prevent failure of justice in any action at law to recover on numerous and extended acts of infringement of patents.

SECOND.

The granting of the order by the Circuit Court rested wholly in its discretion.

By Act of Congress of June 1, 1872, known as the Act of Conformity (R. S., Sec. 914), as construed by this court, the adoption of state practices, pleadings, forms and modes of proceeding

by the Circuit Court rests altogether within the *discretion* of the Circuit Court.

> "The conformity is required to be 'as near "as may be'—not as near as may be *possible* "or as near as may be *practicable*. This in- "definiteness may have been suggested by a "purpose; it devolved upon the judges to be "affected, the duty of construing and decid- "ing, and gave them the power to reject, as "Congress doubtless expected they would do, "any subordinate provision in such State Stat- "utes which, in their judgment would un- "wisely encumber the administration of the "law, or tend to defeat the ends of justice in "their tribunals. While the Act of Congress "is, to a large extent, mandatory, it is also to "some extent, only directory and advi- "sory."
>
> R. R. Co. v. Horst, 93 U. S., 291, 301.
> Cited with approval in Phelps v. Oaks, 117 U. S., 236, 239.

> "It was the purpose of Congress to bring "about a general uniformity in federal and "state proceedings in civil cases, and to con- "fer upon suitors in courts of the United "States the advantage of remedies provided "by state legislation, yet that it was also the "intention to reach such uniformity often "largely through the discretion of the Federal "Courts, exercised in the form of general "rules adapted from time to time, and so "regulating their own practice as may be "necessary or convenient for the advancement "of justice and the prevention of delays in "proceedings."
>
> Shepard v. Adams, 168 U. S., 618, 625.

Such discretion has been exercised by the Circuit Court as is evidenced by Judge Lacombe's decision and opinion quoted on page 5 of this brief. The language of the Act of 1892—"it shall be lawful to take the depositions" is obviously

permissive and discretionary by its very terms. Even under the state practice under the Code of Civil Procedure, as construed by the New York Court of Appeals in the leading case of Jenkins v. Putnam (106 N. Y., 272, 275), although the language of the statute (Code of Civil Proceedure, Section 873) is mandatory in that it provides that:

> "the judge to whom such an affidavit is pre-
> "sented must grant an order for the examina-
> "tion if an action is pending,"

yet the N. Y. Court of Appeals has expressly held that the granting of the order by the judge rests in his sound discretion in all cases, even though the affidavits presented are sufficient under Section 872 of the Code.

Therefore, in the case at bar, when the request by the plaintiff in the court below for this order for examination of defendant's president before trial was made to the Circuit Judge, the granting of said order rested wholly in the *discretion* allowed him not only under the strict New York Code practice, but also allowed him under the act of conformity (R. S., 914), under which latter Act the Circuit Court might have declined to avail itself of such a mode of proof on the ground that it was not

> "necessary or convenient for the advance
> "ment of justice and the prevention of delays
> "in proceedings" (168 U. S., 625)

in Federal tribunals, even if such an order had been a strict matter of right under the State practice.

The purview of the Conformity Act is such that inasmuch as at least one party to a suit in a Federal Court must be necessarily a citizen of the State wherein the court is held, Congress deemed it advisable to secure by said Act general uniformity in proceedings in civil causes in the State and Federal

Courts through the enactment of the permissive, discretionary powers therein contained.

Shepard v. Adams, 168 U. S., 625.

Therefore the argument urged by the plaintiff-in-error in the court below that the Federal Courts will be obligated to submit to any and all modes, however objectionable, prescribed by the Legislatures of the States within their respective circuits, falls, owing to this court's aforesaid repeated limitations of the scope of the Act of Conformity, and it consequently follows that the Act of 1892, far from opening the door to injurious practices, merely adds salutarily to the powers of the Federal Courts by endowing them with such additional means for the prevention of a "failure or delay of justice," as have been approved by the people of their circuits through their Legislatures, and likewise have, as in the present instance, proved acceptable to the Federal Judiciary, and in fact indispensable to the thorough and comprehensive proof of the multitudinous infringements, and resulting damages to which plaintiff herein is entitled.

FINALLY.

The question certified to this Court by the Circuit Court of Appeals for the Second Circuit should be answered in the affirmative.

Dated, New York, April 10th, 1904.

Respectfully submitted,

WALTER D. EDMONDS,

Of Counsel for Defendant-in-Error.

23087

Supreme Court of the United States.

No. 253.—October Term, 1903.

Hanks Dental Association
vs.
International Tooth Crown Company.

On a certificate from the United States Circuit Court of Appeals for the Second Circuit.

[May 16, 1904.]

The certificate in this case is as follows:

"This cause comes here upon a writ of error for the review of the judgment of the Circuit Court for the Southern District of New York, entered upon the verdict of a jury in favor of the defendant in error, The International Tooth Crown Company, sustaining the validity of a patent and awarding damages for infringement. Upon examination of the record it appears that the sole evidence of infringement was found in the deposition of the president of the Hanks Dental Association, the plaintiff in error, taken pursuant to an order of the Circuit Court under section 870 *et seq.* of the Code of Civil Procedure of the State of New York, the defendant in error contending the examination of a party before trial, if permitted by the law of the State, is authorized by act of Congress of March 9, 1892. 27 Stat. L. page 7.

"The taking of the deposition was objected to at every stage and when offered in evidence at the trial it was again duly objected to and to its reception the plaintiff in error duly excepted.

"Whether this practice is warranted or not is the question upon which we desire the instructions of the Supreme Court.

Question Certified.

"Upon the facts above set out the question of law concerning which the court desires the instruction of the Supreme Court is:

"Was the order of the Circuit Court directing the president of the Hanks Dental Association, the defendant in that court, to appear before a master or commissioner appointed pursuant to the provisions of section 870 *et seq.* of the Code of Civil Procedure of the State of New York valid and authorized under the act of March 9, 1892?"

Mr. Chief Justice Fuller delivered the opinion of the Court:

Section 870 of the Code of Civil Procedure of New York provides that "the deposition of a party to an action pending in a court of record or of a person who expects to be a party to an action about to be brought . . . may be taken at his own instance or at the instance of an adverse party or of a co-plaintiff or co-defendant at any time before the trial as prescribed in this article." And succeeding sections set forth how such examinations may be ordered.

In *Ex parte Fisk*, 113 U. S. 713, decided at October term, 1884, it was held that this statute was in conflict with section 861 of the Revised Statutes of the United States, and not within any of the exceptions to the rule marized by Mr. Justice Miller, who delivered the opinion of the court:

"'SEC. 861. The mode of proof, in the trial of actions at common law, shall be by oral testimony and examination of witnesses in open court, except as hereinafter provided.'

'SEC. 863. The testimony of any witness may be taken in any civil cause depending in a District or Circuit Court, by deposition *de bene esse*, when the witness lives at a greater distance from the place of trial than one hundred miles, or is bound on a voyage to sea, or is about to go out of the United States, or out of the district in which the case is to be tried, and to a greater distance than one hundred miles from the place of trial, before the time of trial, or when he is ancient or infirm.' The remainder of this section, and §§ 864 and 865, are directory as to the officer before whom the deposition may be taken, the notice to the opposite party, and the manner of taking, testifying and returning the deposition to the court.

'SEC. 866. In any case where it is necessary, in order to prevent a failure or delay of justice, any of the courts of the United States may grant a *dedimus potestatem* to take depositions according to common usage; and any Circuit Court, upon application to it as a court of equity, may, according to the usages of chancery, direct depositions to be taken *in perpetuam rei memoriam*, if they relate to any matters that may be cognizable in any court of the United States.'

"§ 867 authorizes the courts of the United States, in their discretion, and according to the practice in the State courts, to admit evidence so taken; and §§ 868, 869 and 870 prescribe the manner of taking such depositions, and of the use of the *subpœna duces tecum*, and how it may be obtained."

Mr. Justice Miller then continued: "No one can examine these provisions for procuring testimony to be used in the courts of the United States and have any reasonable doubt that, so far as they apply, they were intended to provide a system to govern the practice, in that respect, in those courts. They are, in the first place, too complete, too far reaching, and too minute to admit of any other conclusion. But we have not only this inference from the character of the legislation, but it is enforced by the express language of the law in providing a defined mode of proof in those courts, and in specifying the only exceptions to that mode which shall be admitted."

And he further said: "Its purpose is clear to provide a mode of proof in trials at law, to the exclusion of all other modes of proof." "It is not according to common usage to call a party in advance of the trial at law, and to subject him to all the skill of opposing counsel, to extract something which he may use or not as it suits his purpose." "Every action at law in a court of the United States must be governed by the rule or by the exceptions which the statute provides. There is no place for excep-

tions made by State statutes. The court is not at liberty to adopt them, or to require a party to conform to them. It has no power to subject a party to such an examination as this."

Sections 721 and 914 were held inapplicable because the law of the State

14 Blatchf. 102, Blatchford, J.; *United States* v. *Pings*, 4 Fed. Rep. 714, Choate, J.; *Fogg* v. *Fisk*, 19 Fed. Rep. 235, Wallace, J.; *Luxton* v. *North River Bridge Company*, 147 U. S. 337, 338.

In *Union Pacific Railroad Company* v. *Botsford*, 141 U. S. 250, decided at October term, 1890, the question was whether a court of the United States could order a plaintiff, in an action for an injury to the person, to submit to a surgical examination in advance of the trial, and it was held that it could not.

Mr. Justice Gray, among other things, said: "Congress has enacted that 'the mode of proof in the trial of actions at common law shall be by oral testimony and examination of witnesses in open court, except as hereinafter provided,' and has then made special provisions for taking depositions. Rev. Stat. §§ 861, 863 *et seq.* The only power of discovery or inspection, conferred by Congress, is to 'require the parties to produce books or writings in their possession or power, which contain evidence pertinent to the issue, in cases and under circumstances where they might be compelled to produce the same by the ordinary rules of proceeding in chancery,' and to nonsuit or default a party failing to comply with such an order. Rev. Stat. § 724. And the provision of § 914, by which the practice, pleadings and forms and modes of proceeding in the courts of each State are to be followed in actions at law in the courts of the United States held within the same State, neither restricts nor enlarges the power of these courts to order the examination of parties out of court."

Ex parte Fisk was quoted from and applied, and the opinion concluded: "The order moved for, subjecting the plaintiff's person to examination by a surgeon, without her consent and in advance of the trial, was not according to the common law, to common usage, or to the statutes of the United States. The Circuit Court, to adopt the words of Mr. Justice Miller, 'has no power to subject a party to such an examination as this.'"

March 9, 1892, the following act was approved (27 Stat. 7): "Chap. 14. An act to provide an additional mode of taking depositions of witnesses in causes pending in the courts of the United States. Be it enacted, &c., That in addition to the mode of taking the depositions of witnesses in causes pending at law or equity in the District and Circuit Courts of the United States, it shall be lawful to take the depositions or testimony of witnesses in the mode prescribed by the laws of the State in which the courts are held."

Mode usually means the manner in which a thing is done, and this act relates to the manner of taking "depositions and testimony," which the title treats as equivalent terms, and which may be so regarded so far as the question before us is concerned. But it is contended that the word "mode" as used in the act has a broader significance and embraces the production of evidence, thereby qualifying section 861, which prescribes the mode of proof.

We cannot concur in this view. The act is clear upon its face and does not call for construction, or, at all events, is susceptible of but one construction. It does not purport to repeal in any part, or to modify, section 861, or to create additional exceptions to those specified in the subsequent sections by enlarging the causes or grounds for taking depositions, and as it is applicable alone to the taking of depositions or testimony in writing, we cannot attribute to it any such effect, nor hold, this being so, that it is supplementary to section 914.

That section refers to "the practice, pleadings, and forms and modes of proceeding in civil causes," and Mr. Justice Blatchford, then District Judge, in *Beardsley* v. *Littell*, thought the expression "forms and modes of proceeding" did not necessarily include the subject of evidence. But be that as it may, we do not think the words "mode of taking" were used in this act with the intention of expanding the scope of the section so as to cover the production of testimony through the examination of a party before trial.

In short, the courts of the United States are not given discretion to take depositions not authorized by Federal law, but, in respect of depositions thereby authorized to be taken, they may follow the Federal practice in the manner of taking, or that provided by the State law. *United States* v. 50 *Boxes*, 92 Fed. Rep. 601.

In *National Cash Register* v. *Leland*, 77 Fed. Rep. 242, it was ruled by the Circuit Court for the District of Massachusetts that the act of 1892 did not "enlarge the instances in which depositions may be taken or in which answers may be obtained upon interrogatories for use as proof in the Federal courts;" and "was only intended to simplify the taking of depositions by providing that the mode of taking in instances authorized by the Federal laws might conform to the mode prescribed by the laws of the State in which Federal courts were held;" and this was approved by the Circuit Court of Appeals for the First Circuit. 94 Fed. Rep. 502. The conclusions announced by the Circuit Court of Appeals for the Fifth Circuit in *Texas & Pacific Railway Co.* v. *Wilder*, 92 Fed. Rep. 953, and by the Circuit Court for the District of Kansas in *Shellabarger* v. *Oliver*, 64 Fed. Rep. 306; for the District Court of Indiana in *Tabor* v. *Indianapolis Journal*, 66 Fed. Rep. 423; for the Western District of Missouri in *Seeley* v. *Kansas City Star*, 71 Fed. Rep. 556; for the Eastern District of

Pennsylvania in *Despeaux* v. *Pennsylvania Railroad Company*, 81 Fed. Rep. 897; for the Eastern District of Missouri in *Zych* v. *American Car & Foundry Company*, 127 Fed. Rep. 728, are to the same effect. The decision of the Circuit Court in this case is to the contrary, 101 Fed. Rep. 306, and was concurred in by the Circuit Court for the Northern District of Washington in *Smith* v. *Northern Pacific Railway Company*, 110 Fed. Rep. 341.

In *Camden & Suburban Railway Company* v. *Stetson*, 177 U. S. 172, October term, 1899, the question of the power of the Circuit Court for the District of New Jersey under a statute of New Jersey providing therefor, was under consideration, and the power sustained. The validity of the statute had been affirmed by the Supreme Court of New Jersey, and in the course of the opinion of this court it was said: "The validity of a statute of this nature has also been upheld in *Lyon* v. *Manhattan Railway Company*, 142 N. Y. 298, although the particular form of that statute would probably be regarded as conflicting with the law of Congress in relation to the examination of a party as a witness before trial, and hence might not be enforced in courts of the United States sitting within the State of New York."

Section 873 of the New York Code of Procedure provided that "in every action to recover damages for personal injuries, the court or judge, in granting an order for the examination of the plaintiff before trial may, if the defendant apply therefor, direct that the plaintiff submit to a physical examination;" and in *Lyon* v. *Manhattan Railway Company*, the Court of Appeals held that the physical examination could only "be procured in the same way and as part of the examination of the party before trial;" that it could not be had apart from and independent of the examination before trial. The reference to the New York statute in *Camden & Suburban Railway Company* v. *Stetson*, so far as it goes, indicates the opinion of the court that the ruling in *Ex parte Fisk* remained unaffected by the act of March 9, 1892, in any substantial particular. We think that that ruling applies, and that the question must be answered in the negative.

So ordered.

True copy.

Test:

Clerk Supreme Court, U. S.